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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/748,733 | 12/30/2003 | Dwight P. Morejohn | GUID-036 | 7537 |

36154 7590 03/26/2007
LAW OFFICE OF ALAN W. CANNON
942 MESA OAK COURT
SUNNYVALE, CA 94086

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| EXAMINER |
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KILKENNY, PATRICK L

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3732

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 03/26/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

ED

BEST AVAILABLE COPY**Office Action Summary**

Application No.

10/748,733

Applicant(s)

MOREJOHN ET AL.

Examiner

Patrick J. Kilkenny

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 11, 13-30, 44 and 45 is/are pending in the application.
- 4a) Of the above claim(s) 2, 16-19, 21 and 23-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1, 11, 13-15, 20, 22, and 44-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to claim 1 introduces new matter in the form of "a retraction actuator." There is no disclosure of "a retraction actuator" in the specification. The only mention of anything similar is that of an "actuator arm." However it is noted that this "actuator arm" is mentioned with regard to the embodiments shown in Figures 8-10 and 16, none of which were previously elected.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 44 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "essentially" in claims 44 and 45 is a

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relative term, which renders the claim indefinite. The term "flat" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 11, 13-15, 20, 22, and 44-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Nicholas et al. (5,967,974). Nicholas et al. discloses an access system with upper and lower spreader portions (Fig. 3, #'s 114 and 126) capable of lifting the rib cage while depressing the abdomen to produce a substernal space. The lower spreader portion comprises a depressor portion capable of depressing the diaphragm and the abdominal organs (Fig. 3, # 112) and the upper portion has two pair of hooks for contacting the sternal area (Fig. 3, #'s 132a). The depressor portion is essentially flat. There are also first and second side portions (Fig. 3, # 113 and opposite side) positioned between the upper and lower spreader portions and are integrally connected to the upper and lower spreader portions. The upper spreader portion also has a screw-type retraction mechanism for lifting and retracting the sternum (Fig. 3, #128).

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Response to Arguments

Applicant's arguments filed 9/25/2006 have been fully considered but they are not persuasive. The system of Nicholas et al. is inherently capable of providing sub-sternal access via the lifting of the ribcage and the depression of the abdominal cavity. It possesses the claimed features of the applicant's system and is essentially the same structure as the embodiment of Figure 2 of the applicant's specification. The fact that it is also capable of spreading individual ribs does not limit the system from being used as a transabdominal access system, just as the applicant's invention could be used to spread ribs. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The applicant argues that the depressor of Nicholas et al. (112) is not flat. It is noted that the applicant only claims that the depressor is *essentially* flat. Figure 2 of Nicholas et al. shows that portion 112, the depressor, is essentially flat. The fact that it also has a flange portion attached to its distal end is irrelevant.

The applicant argues that use of the depressor portion of Nicholas et al. would result in a tearing of the diaphragm. As mentioned previously, the combination of the hook member (112) and the depressor portion (114) create a contoured surface that would be ideal for the curved shape of the diaphragm. It would allow both ventral-dorsal and cranial-caudal depression of the diaphragm.

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The arguments with respect to the amendments of claims 1 and 11 have been addressed above.

Conclusion

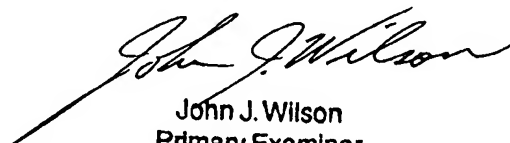
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick J. Kilkenney whose telephone number is (571) 272-8684. The examiner can normally be reached on Mon-Fri, 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Patrick J. Kilkenney



John J. Wilson
Primary Examiner